

REMARKS

Claims 1-50 are pending in this application. Claims 1, 11, 19, 32, 45, 46 and 47-50 are independent claims. Claims 48-50 are added. No new matter is involved. Clear support for the amendments and for the new claims is found throughout Applicants' originally filed disclosure including, for example, in Figs. 6, 7, 8 and 9.

Reconsideration of the application, as amended, is respectfully requested.

Examiner Interview

Applicants acknowledge with appreciation the courtesies extended by Examiner Kieu Vu and John Cabeca to Mr. Robert Webster, their undersigned representative, during the personal interview held on May 18, 2005 and appreciates the Interview Summary. During that interview, Applicants' undersigned representative discussed the outstanding rejections under 35 U.S.C. §112, first paragraph, and under 35 U.S.C. §103(a).

35 U.S.C. §112, First Paragraph Rejection

Claims 1-44 are rejected under 35 U.S.C. §112, first paragraph for failing to comply with the written description requirement. This rejection is respectfully traversed.

The Office Action alleges that support for the exclusionary statements "such that the first main menu item is not displayed in said opened space" in claims 1

and 19; “such that the main menu item is not displayed in said opened space” in claim 11; and that “such that the first main menu items are not displayed in said separately delineated opened space” in claim 32, are not found in the originally filed application.

Applicants respectfully disagree.

Clear basis for the claimed feature in issue is found in Applicants’ original disclosure. For example, originally filed Figs. 6-8 clearly show the claimed feature. Fig. 6 shows five main menu items, the top menu item being “setup.” Fig. 7 shows the setup menu expanded. Fig. 7 clearly shows the result of opening a space between the first main menu item (setup) selected from the main menu items and a second main menu item (video) adjacent to the first main menu item such that the first main menu item (setup) is not displayed in said opened space. All that is contained in the opened space is “Screen Source >Auto scan Hook-up CH Add/Del Focus.” “Setup,” the first main menu item, is clearly not shown in the opened space between the first menu item “setup” and the second menu item “Video” that is adjacent to the first menu item in the main menu.

A similar analysis applies to Figs. 8 and 9. It is clear from an inspection of Figs. 6, 7, 8 and 9, that the language in issue, in claims 1, 11, 19 and 32 is fully supported by Applicants’ original disclosure, which includes Figs. 6, 7, 8 and 9.

In response to these arguments, which were presented in the Amendment filed on August 19, 2004, the Office Action merely concludes that “any negative

limitation or exclusionary proviso must have basis in the original disclosure,”
citing MPEP § 2173.05(i).

Applicants respectfully submit that this response completely fails to comply with MPEP § 707.07(f) because it completely fails to discuss Applicants’ detailed arguments that adequate basis for the language in issue exists in Applicants’ drawing figures 6, 7, 8 and 9.

Because of this failure to comply with MPEP § 707.07(f), Applicants have been denied the fundamental substantive and procedural due process requirements of the Administrative Procedures Act, and this rejection cannot properly be made final. See in this regard, In re Zurko, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

*Applicants also respectfully point out that drawings are part of Applicants’ original disclosure and can be used to provide proper support under 35 U.S.C. § 112, first paragraph for subject matter recited in the claims. See, for example, In re Reynolds, 170 USPQ 94 (CCPA 1971); In re Wolfensberger, 133 USPQ 537 (CCPA 1962); Great Northern Corp. v. Davis Core & Pad Co., 226 USPQ 540, 561 (N.D. GA 1985), *aff’d*, 228 USPQ 356 (Fed. Cir. 1986); Kurt H. Volk, Inc. v. Foundation for Christian Living, 213 USPQ 756, 773 (S.D. N.Y. 1982); Ex parte Porter, 25 USPQ2d 1144, 1146 (BdPatApp&Int 1992); Kennecott Corp. v. Kyocera International Inc., 5 USPQ2d 1194 (Fed. Cir. 1987); In re Schreiber, 128 F.3d 1473, 1477-79, 44 USPQ2d at 1431-32, Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1565, 19 USPQ2d*

1111, 1118 (*Fed. Cir.* 1991), *In re Mraz*, 455 F.2d 1069, 1972, 173 USPQ 25, 27 (CCPA 1972) and *In re Heinle*, 342 F.2d 1001, 1007, 145 USPQ 131, 136 (CCPA 1965).

Copies of two of these decisions were provided to Examiners Vu and Cabeca during the aforementioned interview.

Applicants respectfully submit that the negatively recited features in issue, i.e., “such that the first main menu item is not displayed in said separately delineated opened space” are fully supported by Figs. 7-9, the three figures which show the only examples of the second menu items corresponding to the selected main menu item. None of those three figures show the selected first main menu item in the separately delineated opened space. In other words, there is nothing in Applicants’ disclosure which contradicts these negatively recited features, and the only figures and associated description of those figures in the main body of the specification, which show the second menu items corresponding to the selected main menu item in the separately delineated space do not include the main menu item therein. Accordingly, one of ordinary skill in the art would most certainly recognize that Applicants’ originally filed disclosure provides clear basis for the negatively recited features in issue in this rejection.

To recapitulate, Figs, 6, 7, 8 and 9 provide clear and proper support under 35 U.S.C. §112, first paragraph, for the claimed features “such that the first main menu item is not displayed in said opened space” in claims 1 and 19; “such that

the main menu item is not displayed in said opened space” in claim 11; and that “such that the first main menu items are not displayed in said separately delineated opened space” in claim 32.

Reconsideration and withdrawal of this rejection, and withdrawal of the finality of this office Action, are respectfully requested.

35 U.S.C. §103 Rejection

Claims 1-4, 6, 7, 9-10, 19-22, 24, 26-36, 39-41 and 43-47 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Lokuge in view of USP 5,602,597 to Bertram. This rejection is respectfully traversed.

Applicants respectfully submit that independent claims 1, 11, 19, 32, 45, 46 and 47-50 recite a combination of features in a method for displaying OSD menu items on a screen, including opening a separately delineated space between a first main menu item located in a separately delineated space selected from the main menu items and a second main menu item located in a separately delineated space adjacent to the separately delineated space of the first main menu item, such that the first main menu item is not displayed in the separately delineated opened space. Applicants respectfully submit that these combinations of features as set forth in independent claims 1, 11, 19, 32, 45, 46 and 47-50 are not disclosed or made obvious by the prior art of record, including Lokuge and Bertram.

The Office Action admits that Lokuge does not teach that the menu space is delineated and the first main menu item is not displayed separately in the separately delineated opened space.

Applicants also note that Lokuge does not open a separately delineated space between a first main menu item selected from the main menu items and a second main menu item adjacent to the first main menu item, as recited.

Bertram is cited for its disclosure in Figs. 14 and 15 of showing a main menu with separately delineated main menu items, and opening a separately delineated space with information relating to the selected main menu item, the information not showing the main menu item.

What both Lokuge and Bertram fail to show is the claimed feature of opening a separately delineated submenu space in between two adjacent main menu items.

During the Interview, this was admitted by the Examiners, who nevertheless stated that this is why the rejection was made under 35 U.S.C. §103.

Applicants respectfully submit, as stated during the interview, that Lokuge has no concept of opening a separately delineated space between adjacent main menu items that contains submenu items while not displaying the main menu item to which the submenu pertains.

Lokuge's disclosure and teachings and mindset is entirely different from what is positively recited. Lokuge merely discloses expanding a main menu separately

delineated space, which is a completely separate and distinct concept from what is claimed.

Bertram, the secondary reference, only discloses the concept of cascaded menu cards – see col. 37 and 38 and Figs 12-18, wherein a fundamental feature of each cascaded card is that it is offset from the vertical axis of the card from which it cascades. Moreover, while Bertram delineates between the display areas occupied by the main menu item (the “Information Highway” icon) seen in each of Bertram's Figs. 14 and 15, there is no second main menu item, and the “first” main menu item remains active while the submenu items are displayed. In fact, according to Bertram, an actuation of this individually displayed or “first” menu item while displaying the lower menu levels returns the user to a higher menu level (see col. 37, line 67 to col. 38, line 6) which substantially differs from and is in direct contrast to the claimed methods of the instant invention wherein actuation of a main menu item in a higher menu level takes the user to a lower menu level.

It is clear to Applicants that these two references teach distinctly different modes of operation. Lokuge, on the one hand, discloses merely expanding a given main menu space to include submenu items in a columnar manner, whereas Bertram cascades its submenus in an off-axis manner.

These references actually teach away from being combined as suggested as they teach significantly different layouts of their menus and submenus.

These fundamental differences between these two references would not provide motivation to one of ordinary skill in the art to combine them as suggested.

Furthermore, the assertion in the Office Action that the function control window of the claimed invention is taught by Lokuge is not correct because the “patent-Netscape” window, as shown and described in col. 10, lines 54-65, has no function control capability.

Additionally, while a manipulation on one side, e.g., the left side, of Lokuge’s screen may affect the other side, e.g., the right side, there is no direct and certain correlation between the “Patent-Netscape” window and the various “holiday” files of the “Import Files” folder, as in the case of the function control window and corresponding sub-menu item of Applicants’ invention. There is nothing in the right hand side of Lokuge’s screen in Fig. 11 that can be actuated to affect attributes, e.g., the controllable functions of a digital television, assigned to sub-menu items of the left hand side of Fig. 11. Fig. 11 of Lokuge merely shows that the right hand side of the screen, which has no correlation with the second region of Applicants’ invention, is gradually reduced in size by a further selection of lower menu levels on the left hand side of the screen. On the other hand, in Applicants’ invention, besides being directly related to the selected sub-menu item of the first region, the second region remains the same size regardless of menu manipulation of the first region.

Moreover, Applicants respectfully disagree with the office Action’s assertions regarding motivation for combining these two references, which is to “distinctively

present information to users. A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999). Applicants respectfully submit that the broad conclusionary desire to distinctively present information to users is not clear and particular enough to provide proper motivation to combine these two significantly different references with features that teach away from combining them as suggested, for reasons stated above.

Alternatively, even if it were obvious to modify Lokuge in view of Bertram, the resulting reference combination would not result in, or render obvious, the claimed invention. In this regard, please note, in Fig. 15 of Bertram, that the submenu box covers, and blocks out, main menu items 2-10, instead of being placed in between adjacent main menu items, as recited, and is offset from the columnar format of the main menu.

Further, with respect to claim 11, the rejection presents no objective factual evidence to support the conclusion that Lokuge discloses “erasing the displayed at least one sub-menu item and closing the first space when a new main menu item is

selected using the item indicator.” The rejection refers to col. 7, lines 8-11 of Lokuge to support this allegation.

The claim step in issue actually recites: “(d) erasing the displayed at least one sub-menu item and closing the first separately delineated opened space when a new main menu item is selected from the main menu items using the item indicator.”

Lokuge discloses in col. 7, lines 8-11, that “[a]lternatively, if the category has already been expanded, a mouse button click contracts the category, and its contents disappear from the display.”

“The mouse button click” disclosed by Lokuge is not used to select “a new menu item” as claimed. Rather, the mouse button click of Lokuge is used to contract a category.

Accordingly, the rejection of claim 11 is incorrect when it states that the claimed “erasing” feature is disclosed in lines 8-11 of col. 7 of Lokuge.

Accordingly, the rejection of claim 11 and dependent claims 12-18 is improper and should be withdrawn.

With regard to dependent claims 2-4, 6-7, 9-10, 20-22, 24, 26-31, 33-36 and 39-41, Applicants submit that claims 2-4, 6-7, 9-10, 20-22, 24, 26-31, 33-36 and 39-41 depend, either directly or indirectly, from independent claims 1, 11 and 32, which are allowable for the reasons set forth above, and therefore claims 2-4, 6-7, 9-10, 20-22, 24, 26-31, 33-36 and 39-41 are allowable based on their dependence

from claims 1, 11 and 32. Reconsideration and allowance thereof are respectfully requested.

Claims 5, 8, 23 and 25 stand rejected under 35 USC §103(a) as unpatentable over Lokuge, Bertram and U.S. Patent 6,133,911 to Kim. This rejection is respectfully traversed.

This rejection is improper because of the aforementioned deficiencies of the Lokuge-Bertram reference combination. Moreover, Kim is not applied to remedy the aforementioned deficiencies of Lokuge and Bertram.

Furthermore, Kim does not disclose sequentially displaying menus in a predetermined time period. Kim merely lets a user select menus regardless of the input sequence and discusses the shortcomings of the prior art which merely discusses sequential display of menus.

Accordingly, even if Lokuge and Bertram were modified by Kim, they would not result in, or render obvious the claimed invention.

Reconsideration and withdrawal of this rejection of claims 5, 8, 23 and 25 is respectfully requested.

New Claims

Claims 48-50 have been added. These claims recite the same patentably distinct feature separately delineated space between adjacent main menu items

that the other pending claims recite and, therefore, claims 48-50 are patentable over the applied art at least for this reason.

Moreover, claim 48 additionally recites a combination of features including “wherein, upon a user selection of a main menu item other than the selected main menu item, the first menu item is redisplayed by erasing the at least one sub-menu item displayed in the allocated space, closing the allocated space such that the first and second main menu items again occupy adjacent spaces, and then re-executing said allocation.”

During the interview, Examiners Vu and Cabeca indicated that this feature patentably defines over the applied art.

Applicants respectfully submit that none of the applied references discloses or suggests these recited features.

Accordingly, allowance of claims 48-50, along with claims 1-47 is respectfully requested.

Conclusion

In view of the above amendments and/or remarks, an issuance of a Notice of Allowance is respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert J. Webster, Reg. No. 46,472, at the telephone number of the undersigned below, to

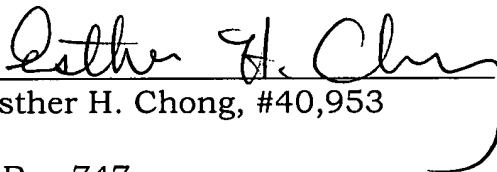
Amendment in reply to January 19, 2005 Office Action Appl. No. 09/716,227
Group: 2173

conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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